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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/592,910	05/14/2007	James H. Silver	CRD5075USPCT	6008

27777 7590 02/23/2010  
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NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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HORNBERGER, JENNIFER LEA

ART UNIT	PAPER NUMBER
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3734

NOTIFICATION DATE	DELIVERY MODE
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02/23/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com  
lhowd@its.jnj.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/592,910	<b>Applicant(s)</b> SILVER, JAMES H.	
	<b>Examiner</b> JENNIFER L. HORNBERGER	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forber (US 2003/0023265) in view of Boyle et al (US 2003/0120303).

Regarding claim 1, Forber discloses a medical filter for therapeutic treatment of a patient, comprising: a first and second end defining a longitudinal axis (Fig. 1, 2, and 12); more than one pair of ribs extending between the first and second ends, the ribs tending to resiliently expand in radially outward directions from a compressed initial shape to an expanded deployed shape; wherein in the compressed initial shape, the ribs each follow a path substantially parallel to the longitudinal axis; wherein in the expanded deployed shape, the ribs each follow an undulating path, such that a first portion (L3) of each pair of ribs extends substantially adjacent to each other for a distance from the first end, and a second portion of each pair of ribs extends substantially adjacent to each other for a distance from the second end in that the ribs converge to become adjacent at the second end (Fig. 2); and an intermediate portion (L1) of each one of a pair of ribs tends to curve away from each other in the expanded deployed shape; wherein in the expanded deployed shape, the filter defines a first and second filtering portion near the first and second end, respectively with a central section therebetween. Forber fails to disclose the medical filter being formed from a single thin walled tube. Boyle et al. disclose providing a single thin walled tubular member, such as a nickel-titanium hypotube, defining a longitudinal axis and having a first and second end, laser cutting more than one pair of struts in the tubular form so as

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to create a desired pattern defining the struts extending between the first and second end of the filter, and treating the struts so that they tend to resiliently expand from a compressed shape to an expanded shape (paragraph 51). It would have been obvious to one of ordinary skill in the art to alternatively form the filter of Forber by laser cutting a single thin walled tubular member to create the desired strut pattern since Boyle et al. has disclosed it is a well known technique in the art for forming the desired strut pattern in self-expandable filters.

Regarding claim 2, Forber discloses in the expanded shape, the intermediate portion (L1) of each one of a pair of ribs tends to curve away from each other and touch one of another pair of ribs (Fig. 1, 2, and 12).

Regarding claim 3, Forber discloses in the expanded shape, a central portion of each rib tends to extend parallel to the longitudinal axis (Fig. 1, 2, and 12).

Regarding claim 4, Forber discloses the filter has at least three pairs of ribs (Fig. 1, 2, and 12).

Regarding claim 5, Forber fails to disclose the filter has six pairs of ribs. It would have been an obvious matter of design choice to include additional pairs of ribs, since applicant has not disclosed that the number of rib pairs solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with 3 pairs of ribs.

Regarding claim 6, Forber discloses the filter is made of Nitinol (paragraph 54).

### ***Response to Arguments***

3. Applicant's arguments filed 1-6 have been fully considered but they are not persuasive. Applicant argues that the references of Forber and Boyle taken as a whole fail to disclose all of the claimed limitations. However, Applicant has failed to specifically point how the combination of Forber and Boyle et al. fails to meet all of the claimed limitations or why one of ordinary skill in the art would not have been motivated to modify Forber based on Boyle et al.

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### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McGuckin et al. (US 20050165441) discloses a medical filter, formed from a single thin-walled tube, comprising a plurality of pairs of ribs following an undulating path.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh

02/01/2010

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734